



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/862,391      | 05/21/2001  | James R. Milne       | 20381-22 (50P4047)  | 8905             |

22242 7590 03/29/2005

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

| EXAMINER |
|----------|
|----------|

YENKE, BRIAN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2614

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/862,391

**Applicant(s)**

MILNE ET AL.

**Examiner**

BRIAN P. YENKE

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Affidavit/Response (28 Oct 04).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The 132 declaration received from the applicant has been received and accepted, thus the previous ground of rejection in view of applicant's submission of prior art has been removed.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 11-12 rejected under 35 U.S.C. 102(b) as being anticipated by  
Bilbrey et al., US 5,227,863.

In considering claims 9 and 11-12,

*a) the claimed a processing chassis...is met by A/D block 70 which receives RGB signals via path 68 (Fig 1) and converts the analog signals into a digital/intermediate*

Art Unit: 2614

signal. Regarding the power supply, the circuitry of the A/D 70 which receives the RGB signals via circuits 62,64 and 66 inherently includes power/power source in order to perform it's intended function.

*b) the claimed a presentation chassis...* is met by video system controller 22/display 52 which receives the digital/intermediate signal from A/D 70 via isolation buffer 72 (Fig 1), where video system controller and display 52 converts the signal into a displayable form.

*c) the claimed an interface coupling the processing chassis and the presentation chassis* is met by bus line 74 (Fig 1).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey et al., US 5,227,863.

In considering claims 1-3, 5, 10, and 13

Bilbrey does not explicitly recite the use of different power sources for the processing and presentation chassis. However, the duplication of a part (i.e. multiple power sources) is considered to be an obvious modification to one of ordinary skill in the

Art Unit: 2614

art (Duplicating part for a multiple effect – *In re Harza*, 274 F.2d 669, 671, 124 USP 378, 380 (CCPA 1960)).

Therefore, it would have been clearly obvious to one of ordinary skill in the art at the time of the invention to modify Bilbrey which discloses a system which receives and displays various received signals which utilizes various processing elements, by using a different power sources if available, in order to provide a system which efficiently supplies power to elements which are active.

In considering claim 4,

Bilbrey discloses the reception of PAL and NTSC signals. However, Bilbrey does not disclose converting the video signal into a high resolution digital signal. Although, it is noted that the conversion of a signal into a high resolution digital signal is notoriously well known in the art, based upon the type of signal received and type of user display. Thus the examiner takes "OFFICIAL NOTICE" regarding such conversion.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bilbrey which discloses the processing/display of NTSC and PAL video signals, by converting the received signals into a high definition signal, when the user's receiving apparatus can display a high definition image, thus improving the picture quality for the viewer.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 2614

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 3-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (see rejection below) of copending Application No. 09/862391. Although the conflicting claims are not identical, they are not patentably distinct from each other because for the reasons as stated below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*a) the claimed a processing chassis...is met by copending claims 1 and 9. Although, the present claim includes "first" digital signal, and the copending claim states "digital signal" the same operation/function is performed thus the naming of the signal is inconsequential. The present claim states "provided to a user" whereas the copending claims states "provided...as an output", since both signals which are provided are the same, the provided to a user or an output is inconsequential.*

*b) the claimed a presentation chassis...is met by copending claim 16. Although, the present claim includes the additional language "the audio and visual conversion being performed in a first domain", the copending claim states converting the audio and video*

Art Unit: 2614

components into a final signal, thus the being performed in a first domain, does not patentably distinguish the claims.

*c) the claimed an interface operative...* is met by copending claim 16, an interface configured...

In considering claim 2-3,

*The claimed wherein the interface comprises separate audio and video communication lines* is met by copending claim 17.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure—see newly cited references on attached form PTO-892.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2614

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Yenke whose telephone number is (571)272-7359. The examiner work schedule is Monday-Thursday, 0730-1830 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John W. Miller, can be reached at (571)272-7352.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703)305-HELP.

General information about patents, trademarks, products and services offered by the United States Patent and Trademark Office (USPTO), and other related information is available by contacting the USPTO's General Information Services Division at:

800-PTO-9199 or 703-308-HELP

(FAX) 703-305-7786

(TDD) 703-305-7785



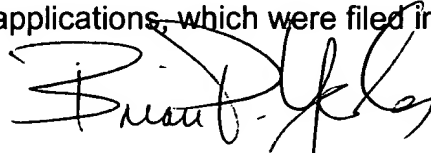
An automated message system is available 7 days a week, 24 hours a day providing informational responses to frequently asked questions and the ability to order certain documents. Customer service representatives are available to answer questions, send materials or connect customers with other offices of the USPTO from 8:30 a.m. - 8:00p.m. EST/EDT, Monday-Friday excluding federal holidays.

For other technical patent information needs, the Patent Assistance Center can be reached through customer service representatives at the above numbers, Monday through Friday (except federal holidays) from 8:30 a.m. to 5:00 p.m. EST/EDT.

The Patent Electronic Business Center (EBC) allows USPTO customers to retrieve data, check the status of pending actions, and submit information and applications. The tools currently available in the Patent EBC are Patent Application Information Retrieval (PAIR) and the Electronic Filing System (EFS). PAIR (<http://pair.uspto.gov>) provides customers direct secure access to their own patent application status information, as well as to general patent information publicly available. EFS allows customers to electronically file patent application documents securely via the Internet. EFS is a system for submitting new utility patent applications and pre-grant publication submissions in electronic publication-ready form. EFS includes software to help customers prepare submissions in extensible Markup Language (XML) format and to assemble the various parts of the application as an electronic submission package. EFS

Art Unit: 2614

also allows the submission of Computer Readable Format (CRF) sequence listings for pending biotechnology patent applications, which were filed in paper form.



BRIAN P. YENKE  
Primary Examiner  
Art Unit 2614



B.P.Y.  
21 March 2005